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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,301

10/11/2005

Thomas Klettke

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26813

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01/26/2009

MUETING, RAASCH & GEBHARDT, P.A.

P.O. BOX 581336

MINNEAPOLIS, MN 55458-1336

EXAMINER

PEPITONE, MICHAEL F

ART UNIT

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1796

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,301	<b>Applicant(s)</b> KLETTKE ET AL.	
	<b>Examiner</b> MICHAEL PEPITONE	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 15-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-20 and 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Zech *et al.* (WO 01/17483). For the purpose of examination, Zech *et al.* (US 6,894,144) was used as the English translation of Zech *et al.* (WO 01/17483).

Regarding claim 15: Zech *et al.* teaches a composition (1:10-11) comprising a mixture of N-alkylaziridino compounds (5:56-62), wherein N-alkylaziridino compounds have aziridino equivalent masses being able to be varied from 500 to 25000 g/equivalent and the number of N-alkylaziridino groups being able to be varied between 1 {corresponding to instant formula Z2} and 4, wherein preferred embodiments contain at least 2, or at least 3 aziridino groups {corresponding to instant formula Z1} (6:53-64), wherein the compounds have different polymer backbones (6:65-7:4).

Regarding claim 16-18: Zech *et al.* teaches N-alkylaziridino polyethers {corresponding to Z1 and Z2} [instant claim 16 and 18] comprising tetrahydrofuran units [instant claim 17] (7:1-4).

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Regarding claim 19: Zech *et al.* teaches N-alkylaziridino polyethers having a mass of at least 500 {based on 500 to 25000 g/equivalent and the number of N-alkylaziridino groups being 1 {corresponding to instant formula Z2} (6:53-57).

Regarding claim 20: Zech *et al.* teaches additives (5:44-6:2; 6:16-19; 6:36-42).

Regarding claim 22: Zech *et al.* teaches a base component comprising N-alkylaziridino compounds {corresponding to Z1 and Z2} and a catalyst component {corresponding to instant formula K} (5:44-6:2).

Regarding claim 23: Zech *et al.* teaches a dental material (1:12-15; 1:55-59, 7:45-50).

The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents and was prepared under similar conditions. Therefore, the claimed effects and physical properties, i.e. a Shore A hardness within 20 minutes of mixing base and catalyst at room temperature of at least 80% of the Shore A hardness reached after 24 h, would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Regarding claim 24: Zech *et al.* teaches dental impression materials (1:10-15).

Regarding claim 25: Zech *et al.* teaches the number of N-alkylaziridino groups equal to 1 {corresponding to instant formula Z2} (6:53-57).

The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents and was

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prepared under similar conditions. Therefore, the claimed effects and physical properties, i.e. an acceleration of the setting rate, would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Regarding claims 26-27: Zech *et al.* teaches pre-dosed pack units of base and catalyst {a kit}, and double chambered cartridges {base and catalyst separated} [instant claim 26] with static mixing tube [instant claim 27] (6:3-5; 6:53-57).

Claim 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Zech *et al.* (WO 01/17483). For the purpose of examination, Zech *et al.* (US 6,894,144) was used as the English translation of Zech *et al.* (WO 01/17483).

Regarding claim 21: Zech *et al.* teaches a method of preparing a composition (1:10-11) comprising a mixture of N-alkylaziridino compounds (5:56-62), wherein N-alkylaziridino compounds have aziridino equivalent masses being able to be varied from 500 to 25000 g/equivalent and the number of N-alkylaziridino groups being able to be varied between 1 {corresponding to instant formula Z2} and 4, wherein preferred embodiments contain at least 2, or at least 3 aziridino groups {corresponding to instant formula Z1} (6:53-64), wherein the compounds have different polymer backbones (6:65-7:4).

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### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Applicant is advised that should claim 15 be found allowable, claim 28 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicant is advised that should claim 21 be found allowable, claim 29 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. See attached form PTO-892.

***Response to Arguments***

Applicant's arguments filed 10/9/08 have been fully considered but they are not persuasive. The rejection of claims 15-27 based on Zech *et al.* (US 6,894,144) [used as the English translation of Zech *et al.* (WO 01/17483)] is maintained for reason of record and following response.

Zech *et al.* (US '144) discloses a composition (1:10-11) comprising a mixture of N-alkylaziridino compounds (5:56-62), wherein N-alkylaziridino compounds have aziridino equivalent masses being able to be varied from 500 to 25000 g/equivalent and the number of N-alkylaziridino groups being able to be varied between 1 {corresponding to instant formula Z2} and 4, wherein preferred embodiments contain at least 2, or at least 3 aziridino groups {corresponding to instant formula Z1} (6:53-64), wherein the compounds have different polymer backbones (6:65-7:4).

As claimed, component Z2 comprises a compound having 1 aziridino group. While preferred embodiments of Zech *et al.* (US '144) disclose a mixture of bisaziridino polyethers (Tables 2 and 5), the number of N-alkylaziridino groups can varied between 1 {corresponding to instant formula Z2} and 4. The reference must be considered for all that it discloses and must not be limited to preferred embodiments [see MPEP 2123].

Furthermore, as claimed, component Z2 comprising a compound having 1 aziridino group does not limit the compound to only 1 aziridino group. A compound having multiple (ex. 2) aziridino groups would overlap in scope with a compound having 1 aziridino group, as the former contains 1 aziridino group {as well additional groups}.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PEPITONE whose telephone number is (571)270-3299. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/  
Supervisory Patent Examiner, Art Unit 1796

MFP  
5-January-09